



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,371	06/09/2006	Yasutaka Shigemoto	60303.59/ok	5752

54070 7590 06/08/2009

HITACHI METALS, LTD.
C/O KEATING & BENNETT, LLP
1800 Alexander Bell Drive
SUITE 200
Reston, VA 20191

EXAMINER

SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
----------	--------------

1793

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

06/08/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JKEATING@KBIPLAW.COM
uspto@kbiplaw.com

Office Action Summary	Application No. 10/596,371	Applicant(s) SHIGEMOTO ET AL.	
	Examiner John P. Sheehan	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I claims 1 to 7 and 13 to 15 in the reply filed on February 19, 2009 is acknowledged.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. In the IDS submitted June 9, 2006, applicants cited US Patent No. 4,756,775. The patent application (06/414,936) that was supposed to have this patent number was withdrawn from issue and no US Patent ever issued with this number (it should be noted that some copies of US Patent 4,756,775 were distributed to the public before it was realized that the patent had actually been withdrawn from issue). Accordingly, the Examiner has lined through 4,756,775 listed on the IDS. However, the application in question subsequently issued as US Patent No. 4,851,058. Therefore the Examiner has cited 4,851,058 on the Form PTO-892 attached to this Office action.
4. The information disclosure statement filed June 9, 2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all

Art Unit: 1793

other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. A copy of WO 00/03403 (published January 20, 2000) was not received by the Examiner. It is noted that a copy of WO 03/003403 (published January 9, 2003) entitled, "Configurable Plasma Volume Etch Chamber" was received by the Examiner but was not listed on the PTO Form 1449.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 to 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I. In claim 1, the last line, it is not clear what antecedent is for the term "its".

II. In claim 1, the last 2 lines, it is not clear whether the phrase, "with a Curie temperature of 610 °C to 700 °C" refers to the Curie temperature of the overall soft magnetic phase or just the Curie temperature of the crystalline component of the soft magnetic phase.

Claim Rejections - 35 USC § 102/103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 to 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Kanekiyo et al. (Kanekiyo '235, U.S. Patent Application Publication No. 2002/0117235, cited by the Examiner) and Kanekiyo et al. (Kanekiyo '339, U.S. Patent Application Publication No. 2002/0017339, cited in the IDS submitted June 9, 2006).

Each of the references teaches a rare earth permanent magnet composition that overlaps the composition recited in the instant claims (Kanekiyo '235, paragraphs [0013] [0179] to [0186] and Kanekiyo '339, paragraph [0014]). The disclosed magnetic compositions have a $R_2Fe_{14}B$ phase (a hard magnetic phase) and soft magnetic phase including α -Fe as recited in the instant claims (Kanekiyo '339, paragraph [0014] and Kanekiyo '235, paragraph [0075]). Each of the references also teaches specific example alloys having compositions that are encompassed by the instant claims (Kanekiyo '235,

Art Unit: 1793

Table 8 and Kanekiyo '339, Tables 1 and 3). Each of the references teaches a process for making the disclosed alloys comprising rapidly solidifying a melt of the alloy (Kanekiyo '339 paragraph [0035] and Kanekiyo '235, paragraph [0013]) and heat treating the rapidly solidified alloy (Kanekiyo '339, paragraph [0134] and Kanekiyo '235, paragraph [0142]). Kanekiyo '339 teaches that during the rapid solidification step the chill roller has a velocity of 7 to 30 m/sec (Table 1) which appears to encompass the chill roll velocity disclosed by applicants (for example, see Figures 3 and 4 of the instant application). Kanekiyo '235 teaches that during the rapid solidification step the chill roller has a velocity of 5 to 20 m/sec (paragraph [0137]) which appears to encompass the chill roll velocity disclosed by applicants (for example see Figures 3 and 4 of the instant application). Thus, each of the references teaches alloy compositions that are encompassed by the compositions recited in the instant claims and which are made by processes which are similar, if not, the same as applicants' disclosed method.

The claims and the references differ in that the references are silent with respect to the Curie temperature of the crystalline phase.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy taught by each of the references has a composition that is encompassed by the instant claims and is made by a process which is similar to, if not the same as, applicants' process of making the instantly claimed alloy. In view of this, the alloy taught by the reference would be expected to possess all the same properties as recited in the instant claims, *In re Best*, 195 USPQ, 430 and MPEP 2112.01.

Art Unit: 1793

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ *In re Spada*, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).” see MPEP 2112.01.

10. Claims 13 to 15 are rejected under 35 U.S.C. 103(a) as obvious over each of Kanekiyo et al. (Kanekiyo ‘235, U.S. Patent Application Publication No. 2002/0117235, cited by the Examiner) and Kanekiyo et al. (Kanekiyo ‘339, U.S. Patent Application Publication No. 2002/0017339, cited in the IDS submitted June 9, 2006).

Kanekiyo ‘339 and Kanekiyo ‘235 teach and are applied as set forth above.

One of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the process step recited in claim 13 amounts to no more than testing a product to determine if the product possesses a desired property, that is, the recited step is no more than a quality control procedure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571)

Art Unit: 1793

272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/
Primary Examiner
Art Unit 1793

JPS